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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,231	10/06/2003	Fredericka D. Lam	7537/80638	1571

22242 7590 07/21/2004

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EXAMINER	
ABDELWAHED, ALI F	
ART UNIT	**PAPER NUMBER**
3712	

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/678,231	LAM ET AL.	
	Examiner	Art Unit	
	Ali Abdelwahed	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18,20,21,23-28,30,31 and 33-58* is/are rejected.

7)☒ Claim(s) *19,22,29 and 32* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 49 and 54 are objected to because of the following informalities:

It is suggested that in:

Claims 49 and 54, insert a period at the end of these claims.

Appropriate correction is required.

Claims 19, 22, 29, and 32 are objected to for being dependent off of a rejected base claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-18, 20, 21, 23-28, 30, 31, and 33-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,601,673 to Nasca in view of U.S. Patent No. 4,079,470 to Deeg et al.

Nasca discloses the claimed invention except for the lens being made of diamond, sapphire, topaz, beryl, quartz, zircon, ruby, cubic zirconium, synthetic rutile, synthetic sapphire, synthetic spinel, strontium titanate, yttrium aluminate, or gadolinium gallium garnet. However, Deeg et al. teaches an artificial eye comprising the

aforementioned limitation (see entire document). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the artificial eye of Nasca, in view of Deeg et al., such that it would provide the artificial eye of Nasca with the aforementioned limitation for the purpose of enhancing the durability of the artificial eye.

Claims 1-4, 9-12, 17, 18, 20, 21, 23-25, 27, 28, 30, 31, 33-35, 37-46, and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 3,480,971 to Smith in view of U.S. Patent No. 4,079,470 to Deeg et al.

Smith discloses the claimed invention except for the lens being made of diamond, sapphire, topaz, beryl, quartz, zircon, ruby, cubic zirconium, synthetic rutile, synthetic sapphire, synthetic spinel, strontium titanate, yttrium aluminate, or gadolinium gallium garnet. However, Deeg et al. teaches an artificial eye comprising the aforementioned limitation (see entire document). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the artificial eye of Smith, in view of Deeg et al., such that it would provide the artificial eye of Smith with the aforementioned limitation for the purpose of enhancing the durability of the artificial eye.

Response to Arguments

Applicant's arguments filed on May 5, 2004 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, the Deeg et al. reference was combined with the Nasca and Smith references merely to teach the concept of having a lens for an eye being made of the materials stated in the rejections made above. Examiner therefore reasserts the rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (703) 305-3311. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA
07/19/2004

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700